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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,175	06/04/2001	Hiromu Ueshima	174.030	9628
38245 7590 09/01/2010 JEROME D. JACKSON (JACKSON PATENT LAW OFFICE) 211 N. UNION STREET, SUITE 100 ALEXANDRIA, VA 22314				
EXAMINER				
BRIER, JEFFERY A				
ART UNIT		PAPER NUMBER		
2628				
NOTIFICATION DATE		DELIVERY MODE		
09/01/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@japalaof.com

Office Action Summary

Application No.

09/856,175

Applicant(s)

UESHIMA ET AL.

Examiner

Jeffery A. Brier

Art Unit

2628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-47 and 52-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-47 and 52-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/C.3)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Page No(s)/Mail Date _____

DETAILED ACTION

Change in Examiners

1. Note the Examiner examining this application has changed to Primary Patent Examiner Jeffery A. Brier.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/04/2010 has been entered.

Response to Amendment

3. The amendment filed on 02/04/2010 has been entered.
4. The amendment filed 02/04/2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The amendment to page 8 enters new matter because applicant is associating a broad storage medium with a narrower previously disclosed external memory 44 but is not limiting the computer readable storage medium to external memory 44.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. The amendment filed 03/23/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The amendment to page 1 enters new matter because applicant is incorporating by reference documents which were not incorporated by reference at the time of filing this application. The Examiner notes this application was filed before September 21, 2004, therefore, 37 CFR 1.57(a) which applies to applications filed on or after September 21, 2004 does not apply to this application. See MPEP 608.01(p) of which the first paragraph is reproduced below with emphasis added by underlining.

The Director has considerable discretion in determining what may or may not be incorporated by reference in a patent application. *General Electric Co. v. Brenner*, 407 F.2d 1258, 159 USPQ 335 (D.C. Cir. 1968). >Effective October 21, 2004, the Office codified in 37 CFR 1.57(b) – (g) existing practice with respect to explicit incorporations by reference with a few changes to reflect the eighteen-month publication of applications. In addition, 37 CFR 1.57(a) was added to provide a safeguard for applicants when a page(s) of the specification, or a portion thereof, or a sheet(s) of the drawing(s), or a portion thereof, is inadvertently omitted from an application, such as through a clerical error. 37 CFR 1.57(a) applies to applications filed on or after September 21, 2004. 37 CFR 1.57(a) permits inadvertently omitted material to be added to the application by way of a later filed amendment if the inadvertently omitted portion of the specification or drawing(s) is completely contained in a prior-filed application (for which priority/benefit is claimed) even though there is no explicit incorporation by reference of the prior-filed application. See MPEP § 201.17 for discussion regarding 37 CFR 1.57(a).

Applicant is required to cancel the new matter in the reply to this Office Action.

6. The replacement sheet of drawing for figure 3 overcomes the drawing objection set forth in the office action mailed on 06/18/2009 at paragraph 4.

7. The amendment to the specification does not overcome the specification objection set forth in the office action mailed on 06/18/2009 at paragraph 5 because the claims 52 and 53 claim "information storage medium" while applicant added "computer readable storage medium" to the specification.

8. The terminal disclaimer filed on 02/04/2010 overcomes the provisional obvious type double patenting rejection set forth in the office action mailed on 06/18/2009 at paragraphs 1-3.

Specification

9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter (e.g., information storage medium). See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

Response to Arguments

10. Applicant's arguments filed 02/04/2010 have been fully considered but they are not persuasive in view of the new grounds of 35 USC 112 first rejection.

An analysis of the claimed invention of claims 26-47 and 54-57 with regard to the prior art will be held in abeyance until the claimed invention has been clarified since the specification does not support these claims and since the metes and bounds of these claims are not definite. Thus, a prior art rejection or an indication of allowability cannot be made with the currently pending claims. In re Steele, 305 F.2d 859, 134 USPQ 292

(CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

An analysis of the claimed invention of claims 52 and 53 with regard to the prior art is set forth below even though the specification does not support these claims and the metes and bounds of these claims are not definite.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 26-47 and 52-57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 26-47 and 52-57:

Independent claims 26, 39, 52, and 53 were amended to claim "to produce a movement for simulating an interception of a ball" and independent claims 26 and 52 were amended to claim "to produce a movement for simulating an interception of a ball". Applicants specification fails to convey these new claim limitations for at least the following two claim interpretations.

Claim interpretation 1:

These claim limitations claim any swing of the input device will simulate an interception of a ball. However, applicants specification is very clear with regards to determining if the bat or racket meets the ball. If the determination is such that the bat or racket does not meet the ball interception has not occurred. Thus, the claims claim an invention not conveyed by applicants specification. Note applicants specification at page 6 lines 10-20, page 13 lines 12-21, and page 22 lines 4-14.

page 6 lines 10-20 states (emphasis by underlining):

10 In the game machine 12, when the player actually swings the bat input device 32, a
signal from the acceleration switch or acceleration sensor (hereinafter referred) is
transmitted as an infrared-ray signal from the infrared-ray LED 34 to the infrared-ray
15 receiver 30. The ball a43 is moved toward the pitcher a41 or another athlete a42 as if the
ball a 43 was hit back by the bat, according to timing the bat input device 32 reaches a
predetermined moving speed and a position of the ball a43 on the screen. It is
discriminated, according to a position where the ball a43 has moved to, whether gained is
a hit (home run, three-base hit, two-base hit, one-base hit), foul, fly ball, grounder, out,
safe or the like. However, where there is a deviation between the position of the bat when
20 the bat input device 32 is swung and the position of the ball a43 on the screen, a missed
swing for example is recognized.

page 13 lines 12-21 states (emphasis by underlining):

The fact "YES" has not been determined in step \$4 before reaching the ball a43 to
the catcher position means that a peak of the rotation speed has not detected in the
duration between pitching of the ball a43 by the pitcher a41 and reaching the ball a43 to
15 the catcher position. In other words, this means a disagreement between the timing of
swinging the bat input device 32 by the game player and the timing of moving the ball
a43, i.e. swing has been made after catching of the ball a43 by the catcher. In this case,
game processor 40 determines as "missed swing". However, where the rotation speed
remains "0" in the step \$3, it means that the bat input device 32 has not been swung. In
20 this case, the game processor 40 determines as to strike or ball depending upon a ball a43
reach position and established strike zone.

page 22 lines 4-14 states (emphasis by underlining):

5 The fact of determination "YES" in the step \$23 before the ball a43 has reached
the ball-return limit position means that no peak of the moving speed has detected before

10 reaching the ball-return limit position after hitting back of the ball a43 or hitting a serve ball a43 by the opponent player. In other words, this means a disagreement between the timing of swinging the racket input device 80 by the game player and the timing of movement of the ball a43, i.e. the swing was after the ball a43 has reached the ball-return limit position. In this case, the game processor 40 determines as "missed swing". However, the moving speed remaining "0" in the step \$22 means that the racket input device 80 has not been swung. In this case, the game processor 40 will determine as out ball or safe ball, by whether the ball a43 reach position is on the ping-pong table a51 (Figure 14) or not.

Claim interpretation 2:

These claim limitations claim the input device produces a movement for simulating an interception of a ball such as controlling the movement of the bat or racket to produce a simulation of an interception of a ball or providing movement feedback to the gamer to produce a simulation of an interception of a ball. Thus, the claims claim an invention not conveyed by applicants specification.

Information storage medium claims 52 and 53:

The external memory described at page 8 lines 11-15 of applicants specification fails to convey applicants broad claim to an information storage medium including a program for performing the method of these claims. The external memory is described as being ROM or RAM (SRAM and/or DRAM). SRAM and DRAM are volatile memory which eventually loses its data when power is turned off. To one of ordinary skill in the art the described RAM does not convey the claimed information storage medium since the described RAM are volatile memory transitorily storing data. To one of ordinary skill in the art the described ROM does not convey the scope of the claimed information storage medium.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 26-47 and 52-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 26, 39, 52, and 53 were amended to claim "to produce a movement for simulating an interception of a ball" and independent claims 26 and 52 were amended to claim "to produce a movement for simulating an interception of a ball" and independent claims 26 and 39 previously claimed "after a hit" and independent claims 52 and 53 were amended to claim "after a hit". The claimed "after a hit" conflicts with the claimed "to produce a movement for simulating an interception of a ball" because the input device is being claimed as always producing a movement which is an interception which is a hit while the claimed "after a hit" is a determination of movements which may produce a hit.

Claims 33, 34, 42, and 43:

Claims 33 and 42 claim "a memory" twice, see claim 33 at lines 2 and 4 and claim 42 at lines 2 and 4, and each of these claims make reference to "said memory". Therefore, the claimed "said memory" does not clearly refer to which of the two claimed memories has the program code. Dependent claims 34 and 43 do not correct this issue.

Claim 47:

The claimed "light receiving element" on the input device's second signal-generator is unclear with regards to which infrared-ray light it receives. With reference to figure 5 infrared-ray transmitter LED diode 34 sends light in a direction different than other diodes 34. With reference to figure 4 and page 9 lines of specification 5-10 infrared-ray transmitter LED diode 34's infrared-ray's are outputted through light transmission part. Perhaps applicant intends to claim the the infrared-ray receiving part 30 provided on the game machine 12.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 52 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Lipps et al. US Patent No. 5,741,182.

The limitations of these two claims defining the ball game apparatus, see claim 52 at lines 2-13 and claim 53 at line 2-11, are considered to be intended use of the program. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The limitations of these two claims defining the ball game apparatus, see claim 52 at lines 2-13 and claim 53 at line 2-11, are considered to be in the preamble of these information storage medium claims. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The program and game processing functions of these claims, claim 52 at lines 18-25 and claim 53 at lines 16-22, with regard to Lipps et al. alone were previously addressed in the Final Rejection mailed on 06/18/2009 at pages 8, 26, and 27 and are hereby incorporated by reference. Thus, Lipps et al. anticipates claim 52 at lines 18-25 and claim 53 at lines 16-22 for the previous reasons of record.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A. Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:30 to 4:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xiao Wu can be reached at (571) 272-7761. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffery A. Brier/
Primary Examiner, Art Unit 2628